REMARKS

Summary

In the Office Action, claims 1-19 stand rejected. In this response, claims 1, 2, 3, 7, 10, 12, and 16 are amended, claims 4-6, 8, 9, 13-15, and 17-19 are canceled, and claims 20-24 are added. No new matter has been introduced.

Claim Rejections under 35 U.S.C. § 102(e)

Claims 1, 2, 4, 7, 10, 11, 12, 13, 14, 18, and 19 are rejected under § 102(e) as being anticipated by U.S. Publication 2002/0107930 of Itoh ("*Itoh*"). In response, claims 1, 2, 7, 10, and 12 are amended. In addition, claims 4, 13, 14, 18, and 19 are canceled thereby rendering moot the rejections thereof. Applicants respectfully assert that independent claims 1, 10, and 12, and claims 2, 7, and 11 depending therefrom, now stand in condition for allowance.

Independent claim 1, as amended, is directed to an e-mail method for distributing an e-mail message from a local e-mail client to selected ones of a pre-determined distribution list via a remote e-mail server. The claimed method includes, among other things:

> addressing, using the e-mail client, the e-mail message to the distribution list;
> selecting, using the e-mail client, a subtractive list, which when applied to the distribution list, determines a modified distribution list comprising members of the distribution list not present in the subtractive list; and
> submitting, by the e-mail client, an indicator of the distribution list and an indicator of the subtractive list to the e-mail server so that the e-mail server may determine the modified distribution list.

Thus, indicators of a distribution list (e.g., including members of a group) and a subtractive list are submitted by a local e-mail client to an e-mail server for determining a modified distribution list. This novel method may be useful, for example, for implementation in an organization so that one or more of the same

distribution lists and/or subtractive lists, and the determination therefrom of modified distribution lists, may be used.

In contrast, *Itoh* fails to disclose the method of claim 1. *Itoh* discloses a method for <u>setting</u> destinations of e-mail using an addition symbol (+) or a subtraction symbol (-) placed between one destination and another destination to add or delete the address of a group member from a particular group. *Itoh* discloses that such setting of destinations is done using a selection window (i.e., at an e-mail client) wherein the addition or deletion of destinations takes place prior to any transmission. *See Itoh*, ¶¶ [0129]-[0133]; Fig. 8; Fig. 9. Thus, *Itoh* cannot be said to disclose, at a minimum, submitting, by a local e-mail client, at least an indicator of a distribution list and of the subtractive list to an e-mail server so that the e-mail server may determine the modified distribution list.

Accordingly, *Itoh* cannot be said to anticipate the invention of claim 1. Independent claim 12 contains limitations similar to that of claim 1 and thus is allowable for at least the same reasons claim 1 is allowable.

With respect to claim 10, said claim is directed to an e-mail server receiving from the e-mail client, an email message addressed to a first indicator for a distribution list, and a second indicator for a subtractive list, which when applied to the distribution list, determines a modified distribution list comprising members of the distribution list not present in the subtractive list. However, *Itoh* makes no such teaching as described above. Rather, Itoh discloses an e-mail server receiving destination addresses that the e-mail client has already populated according to the setting scheme described above. *See Itoh*, ¶¶ [0129]-[0133]; Fig. 8; Fig. 9.

Accordingly, Itoh also cannot be said to anticipate claim 10.

Claims 2, 7, and 11 depend from one of claims 1, 10, and 12, either directly or via an intervening claim, thereby incorporating the limitations thereof. Therefore, claims 2, 7, and 11 also are allowable over *Itoh*.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 3, 5, 6, 8, 9, 15, 16, and 17 are rejected under § 103(a) as being unpatentable over *Itoh* in view of the allegedly well-known art of web-based email services such as Hotmail, Yahoo, etc.

As stated previously, claims 5, 6, 8, 9, 15, and 17 are canceled, thereby rendering moot the rejections thereof.

Regarding the remaining rejections, independent claims 1 and 12 are allowable over *Itoh* as previously discussed. Claims 3 and 16 depend from one of allowable claims 1 and 12, and thus are allowable over *Itoh* for at least the same reasons.

Even combining *Itoh* with features of web-based email services would fail to remedy *Itoh*'s deficiencies. Even assuming for the sake of argument that features of web-based email services could be said to teach applying, by an e-mail server, a subtractive list to a distribution list to determine a modified distribution list, said web-based email services cannot be said to teach submitting, by a local e-mail client, at least an indicator of a distribution list and of the subtractive list to an e-mail server so that the e-mail server may determine the modified distribution list.

Accordingly, independent claims 1 and 12 are allowable over *Itoh* even if combined with allegedly known web-based email services. As claims 3 and 16 depend from one of claims 1 and 12, either directly or via an intervening claim, said claims also are allowable.

New Claims

Claims 20-24 have been added. Independent claim 20 is directed to an electronic-mail method for distributing an e-mail message to selected members of first and second distribution lists, comprising addressing the e-mail message to the first and the second distribution lists; and selecting a subtractive list, which when applied to the first and the second distribution lists, determines a modified

distribution list comprising members of the first and the second distribution lists that are members of both the first and the second distributions lists.

In contrast, *Itoh* fails to disclose the method of claim 20. As noted previously, *Itoh* discloses a method for <u>setting</u> destinations of e-mail using an addition symbol (+) or a subtraction symbol (-) placed between one destination and another destination to add or delete the address of a group member from a particular group. *Itoh* discloses that such setting of destinations is done using a selection window (i.e., at an e-mail client). *See Itoh*, ¶¶ [0129]-[0133]; Fig. 8; Fig. 9. Nowhere, however, does *Itoh* disclose addressing the e-mail message to the first and the second distribution lists, and selecting a subtractive list, which when applied to the first and the second distribution lists, determines a modified distribution list comprising members of the first and the second distribution lists that are members of both the first and the second distributions lists.

Accordingly, *Itoh* cannot be said to anticipate the invention of claim 20. Claims 21 and 22 depend from claim 20 and thus are allowable for at least the same reasons claim 20 is allowable.

With respect to independent claim 23, said claim is directed to an article comprising a machine-accessible media having associated data for distributing from an e-mail client an e-mail message to selected members of a distribution list via an e-mail server, wherein the data, when accessed, results in a machine performing at least the operation of receiving from the e-mail client, an email message addressed to a first indicator for a distribution list, and a second indicator for a subtractive list, which when applied to the distribution list, determines a modified distribution list comprising members of the distribution list not present in the subtractive list. However, *Itoh* makes no such teaching as described above. Rather, Itoh discloses an e-mail server receiving destination addresses that the e-mail client has already populated according to the setting scheme described above. *See Itoh*, ¶¶ [0129]-[0133]; Fig. 8; Fig. 9.

Accordingly, Itoh also cannot be said to anticipate claim 23.

Claim 24 depends from claim 23 thereby incorporating the limitations thereof. Therefore, claim 24 also is allowable over *Itoh*.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that the pending claims are in condition of allowance. Thus, entry of the offered amendments and early issuance of Notice of Allowance is respectfully requested.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

SCHWABE, WILLIAMSON & WYATT, P.C.

Date: __June 20, 2007__   by: _____ /Angela M. Sagalewicz/ _____
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